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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,015	06/24/2003	Ricardo SoonLian Lim	S104.12-0041/STL 11309.00	2576
7590 07/18/2006			EXAMINER	
KIRK A . CESARI SEAGATE TECHNOLOGY LLC 1280 DISC DRIVE SHAKOPEE, MN 55379-1863			PATEL, NITIN C	
			ART UNIT	PAPER NUMBER
			2116	

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/603,015	<b>Applicant(s)</b> LIM ET AL.	
	<b>Examiner</b> Nitin C. Patel	<b>Art Unit</b> 2116	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This is in responsive to amendments filed on 19 June 2006.
2. Claim 21 has been added new.
3. Claims 1 – 21 are currently pending with the application.

### ***Specification***

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Objections***

5. Claim 13 is objected to because of the following informalities:
  6. In the claim 13, replace "the information" in line 3 on page 5 with ---an information--- as information has not previously recited in the claim.
- Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 1, 3, 4, 7, 9, 10, 13 – 17, and 19 – 21 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements with essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

The omitted steps are:

8. The conditional statement language of the claims 1, 3; 4, 7, 9, 10, 13 – 17, and 19 – 20, in last paragraph, the conditional statement " if the information is not successfully read -----or the information is not successfully read from any copy of the

information after the maximal number of attempts", which is incomplete conditional statement and unclear or not clearly claimed or missing essential elements/steps/components [what happened after the condition of "the information is not successively read from any copy of the information after the maximal number of attempts"]].

9. In method claim 21, there are missing essential elements and relationship with essential steps in establishing minimal and maximal numbers that define two levels of retry attempts to read information on a storage medium.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1– 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

11. The conditional statement language of the claims 1 – 20, in last paragraph, " if the information is not successfully read -----or the information is not successfully read from any copy of the information after the maximal number of attempts" raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible results to form the basis of statutory subject matter under 35 U.S.C. 101. [This can be overcome by achieving a concrete, useful,

and tangible results e.g. displaying message or sending notification message “not successfully read or read error” when ending the process].

12. The method claim 21, the claimed invention is directed to non-statutory subject matter. In the claim 21, “a method comprising: establishing minimal and maximal numbers that define two levels of retry attempts to read information on a storage medium” raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible results to form the basis of statutory subject matter under 35 U.S.C. 101.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claim 21 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Russel, US Patent 6,332,204 B1.

14. As to claim 21, Russell discloses a method comprising:

a. establishing [determining] minimal [number of retry less than predefined threshold, i.e.number of retry when read attempt is successful] and maximal numbers [number of retry attempts exceeds predefined threshold/limit] that define two levels [retry is reliable or failing to read/unreliable] of retry attempts [repetitively retrying] to

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read [read request] information [data] on a storage medium [204 disk storage, fig. 2]  
[abstract, col. 2, lines 5 – 19, col. 4, lines 41 – 46, fig. 3].

15. **Examiner's note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

16. **Prior Art not relied upon:** Please refer to the references listed in attached PTO-892, which, are not relied upon for claim rejection since these references are relevant to the claimed invention.

### ***Response to Arguments***

17. In response to applicant's arguments regarding traversing the use of, "pages 1 – 2 of the specification of the present invention is AAPA [applicant admitted prior art]. Those pages do not use the term prior art." The examiner disagrees, since in the specification of the present invention in Background of the invention, "Due to its criticality, it is common to store several copies----- the system sectors". Furthermore, it is stated, "It is common to perform multiple retries-----before attempting to read another copy." Here, "it is common" in the background of invention is broad enough to generally

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mean as known to all, and is considered as admission as prior art even though the term "prior art" is not used.

18. In response to request for citation in MPEP, where disclosure can be construed as AAPA [applicant admitted prior art] is in chapter 2129 section I – III under Admissions as Prior ART.

19. Applicant's arguments with respect to claim 21, has been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nitin C. Patel whose telephone number is 571-272-3675. The examiner can normally be reached on 6:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H. Browne can be reached on 571-272-3670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Nitin C. Patel", with a stylized flourish at the end.

Nitin C. Patel  
Patent Examiner  
Technology Centre 2100

July 12, 2006